

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JUN NAKAMURA

Appeal No. 1997-0373
Application No. 08/151,694¹

HEARD: July 14, 1999

Before McCANDLISH, Senior Administrative Patent Judge, COHEN and
NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 12 to 15, 17, 21 to 25 and 27.² Claim 19 has been allowed. Claims 16 and 26 have been objected to as

¹ Application for patent filed November 15, 1993.

² Claims 13, 17, 21 to 23 and 27 have been amended subsequent to the final rejection (Paper No. 5, mailed April 17, 1995).

Appeal No. 1997-0373
Application No. 08/151,694

depending from a non-allowed claim. Claims 1 to 11, 18 and 20
have been canceled.

We REVERSE.

BACKGROUND

The appellant's invention relates to a stencil master plate sheet pay-out device for paying out a stencil master plate sheet from a sheet roll. An understanding of the invention can be derived from a reading of exemplary claim 12, which appears in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Wooster et al. (Wooster) 21, 1933	1,935,970	Nov.
Tetro et al. (Tetro) 1980	4,199,118	Apr. 22,
Newell et al. (Newell) 1989	4,848,698	July 18,

Claims 12 to 15, 17, 21 to 25 and 27 stand rejected under 35 U.S.C. § 103 as being unpatentable over Tetro in view of Wooster and Newell.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the examiner's answer (Paper

No. 14, mailed February 20, 1996) and the supplemental examiner's answer (Paper No. 17, mailed May 13, 1996) for the examiner's complete reasoning in support of the rejection, and to the appellant's brief (Paper No. 12, filed October 17, 1995), reply brief (Paper No. 15, filed April 18, 1996) and supplemental reply brief (Paper No. 18, filed July 12, 1996) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 12 to 15, 17, 21 to 25 and 27 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

The appellant argues that the applied prior art does not suggest the claimed subject matter. We agree.

All the claims under appeal require (1) a stencil master plate sheet to carry thereon information indicative of the outer diameter of the sheet; (2) a reading means/photo electric sensors for reading/sensing the information carried on the stencil master plate sheet; and (3) control means/unit for changing the variable resistance applied to the sheet roll according to the information read/sensed by the reading

means/photo electric sensors. However, these limitations are not suggested by the applied prior art. In that regard, none of the applied prior art even teaches a stencil master plate sheet. To supply this omission in the teachings of the applied prior art, the examiner made a determination (answer, p. 3) that "the sheet is a stencil master plate sheet would have been an obvious type of sheet" to an artisan to use in the apparatus. However, this determination has not been supported by any evidence³ that would have led an artisan to

³ Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg. v. SGS Imports Intern., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), although "the suggestion more often comes from the teachings of the pertinent references," In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not "evidence." E.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993); In re Sichert, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977).

have modified Tetro's sheet to be a stencil master plate sheet.

In addition, it is our view that the only suggestion for modifying Tetro based upon the teachings of Wooster and Newell in the manner proposed by the examiner (answer, pp. 4-5) to meet the above-noted limitations stems from hindsight knowledge derived from the appellant's own disclosure, not from the teachings of the applied prior art. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

For the reasons stated above, the decision of the examiner to reject claims 12 to 15, 17, 21 to 25 and 27 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 12 to 15, 17, 21 to 25 and 27 under 35 U.S.C. § 103 is reversed.

REVERSED

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
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)	
)	
)	BOARD OF PATENT
IRWIN CHARLES COHEN)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
Administrative Patent Judge)	

Appeal No. 1997-0373
Application No. 08/151,694

Page 9

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APPEAL NO. 1997-0373 - JUDGE NASE
APPLICATION NO. 08/151,694

APJ NASE

SAPJ McCANDLISH

APJ COHEN

DECISION: **REVERSED**

Prepared By: Gloria

Henderson

DRAFT TYPED: 19 Jul 99

FINAL TYPED:

HEARD: July 14, 1999